

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 19

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte GARY A. SIGEL and ROMAN C. DOMSZY

Appeal No. 96-2575
Application 08/051,886¹

ON BRIEF

Before KIMLIN, PAK and WALTZ, Administrative Patent Judges.

KIMLIN, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1-7, and 9-18, all the claims remaining in the present application. A copy of illustrative claim 1 is appended to this decision.

The examiner relies upon the following references as evidence of obviousness:

¹Application for patent filed April 26, 1993.

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Kratel et al. (Kratel '487)	3,953,487	Apr. 27, 1976
McDaniel	4,190,457	Feb. 26, 1980
Kratel et al. (Kratel '587)	4,191,587	Mar. 04, 1980

Appellants' claimed invention is directed to a process for preparing a xerogel that comprises contacting an inorganic wet gel with a silicon-nitrogen compound of the recited formula. The xerogels of the present invention have a low density and high porosity and find utility as thermal insulation.

The appealed claims stand rejected under 35 U.S.C. § 103 as being unpatentable over McDaniel in view of Kratel '487 and Kratel '587.

Upon careful consideration of the opposing arguments presented on appeal, we concur with appellants that the prior art applied by the examiner fails to establish a prima facie case of obviousness for the claimed subject matter. Accordingly, we will not sustain the examiner's rejection.

There is no dispute that McDaniel discloses a process for preparing a xerogel comprising contacting an inorganic hydrogel with a silicon-nitrogen compound. However, as appreciated by the examiner, McDaniel does not disclose the

use of silicon-nitrogen compounds of the recited formula.

Consequently, the examiner

relies upon the Kratel references for teaching a reaction of appellants' silicon-nitrogen compounds with SiO_2 . However, as explained by appellants, the flaw in the examiner's reasoning is that the Kratel references are not directed to reacting the silicon-nitrogen compounds with a wet gel to form a xerogel, as required by the appealed claims and disclosed by the primary reference, McDaniel. While the examiner points to the mention of aerogels and xerogels in the Kratel patents, the references teach reacting the silicon-nitrogen compounds with dehydrated silica gels or xerogels, not with wet inorganic gels to form a xerogel. As properly noted by appellants, the "fine-particle size SiO_2 to be reacted with the organosilicon compounds" (Kratel '487 at column 2, lines 32 and 33) is a dry, dehydrated material, not a wet gel. In essence, whereas appellants and McDaniel are directed to forming a xerogel from an inorganic wet gel, the Kratel references are concerned with modifying dry SiO_2 (which can be already-formed xerogels) by a

reaction with a silicon-nitrogen compound followed by mechanical comminution. In our view, the Kratel references would have provided no teaching or suggestion of modifying the process of McDaniel for forming an inorganic xerogel.

Inasmuch as the applied prior art fails to establish a prima facie case of obviousness, it is unnecessary to evaluate the probative value of the Domszy declaration.

One final point remains. Appellants at page 5 of their principal brief, urge separate patentability for ten different groups of claims (A-J) and provide appropriate arguments in the body of the brief. As a result, the examiner erred in not agreeing with appellants that the appealed claims do not stand or fall together because "the claims would not be separately patentable if claims 1 and/or 10 were unpatentable. Further, the same combination of references is applied against every claim on appeal herein." (page 2 of answer). When an appellant provides separate arguments for different claims on appeal, it is the examiner's burden to treat every separately argued claim and provide factual support for a rejection under 35 U.S.C. § 103, whether or not the same combination of

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references is applied against every separately argued claim.
We invite the examiner's attention to 37 CFR § 1.192 (c)(7)
and (c)(8), as well as Ex parte Schier, 21 USPQ2d 1016, 1018-
19 (Bd. Pat. App. & Int. 1991).

In conclusion, based on the foregoing, the examiner's
decision rejecting the appealed claims is reversed.

REVERSED

EDWARD C. KIMLIN)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
CHUNG K. PAK)	APPEALS AND
Administrative Patent Judge)	INTERFERENCES
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THOMAS A. WALTZ)	
Administrative Patent Judge)	

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